

## UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,403	03/26/2004	Atsuko Mitsuba	0229-0798PUS1	7549
2292	7590 03/08/2005		EXAM	INER
	EWART KOLASCH &	PASSANITI, SEBASTIANO		
PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER
	,		3711	
•			DATE MAILED: 03/08/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/809,403	MITSUBA, ATSUKO			
Office Action Summary	Examiner	Art Unit			
	Sebastiano Passaniti	3711			
The MAILING DATE of this communicate Period for Reply	tion appears on the cover sheet with	h the correspondence address			
A SHORTENED STATUTORY PERIOD FOR THE MAILING DATE OF THIS COMMUNICA  - Extensions of time may be available under the provisions of 3' after SIX (6) MONTHS from the mailing date of this communic  - If the period for reply specified above is less than thirty (30) da  - If NO period for reply is specified above, the maximum statuto  - Failure to reply within the set or extended period for reply will, Any reply received by the Office later than three months after the earned patent term adjustment. See 37 CFR 1.704(b).	TION. 7 CFR 1.136(a). In no event, however, may a repetion. ays, a reply within the statutory minimum of thirty may period will apply and will expire SIX (6) MONT by statute, cause the application to become ABA	ply be timely filed  (30) days will be considered timely.  HS from the mailing date of this communication.  INDONED (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed of	on <u>see detailed Office action</u> .				
	☐ This action is non-final.				
3) Since this application is in condition for	, —				
Disposition of Claims					
4)  Claim(s) 1-14 is/are pending in the application.  4a) Of the above claim(s) is/are withdrawn from consideration.  5)  Claim(s) is/are allowed.  6)  Claim(s) 1-14 is/are rejected.  7)  Claim(s) is/are objected to.  8)  Claim(s) are subject to restriction and/or election requirement.					
Application Papers					
9) The specification is objected to by the Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the 11) The oath or declaration is objected to by					
Priority under 35 U.S.C. § 119		·			
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>					
Attachment(s)  1) Motice of References Cited (PTO-892)		ummary (PTO-413)			
<ol> <li>Notice of Draftsperson's Patent Drawing Review (PTO-3)</li> <li>Information Disclosure Statement(s) (PTO-1449 or PTO Paper No(s)/Mail Date <u>03/26/2004</u>.</li> </ol>	O/SB/08) 5) D Notice of Inf	/Mail Date formal Patent Application (PTO-152)  Continuation Sheet			

Continuation of Attachment(s) 6). Other: Highlight of US ('120) and US ('310).

Art Unit: 3711

## **DETAILED ACTION**

This Office action is responsive to communication received 03/26/2004 – application papers filed; priority papers received, IDS, preliminary amendment.

Claims 1-14 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 5, 7, 8, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen ('310). Reference is made to the attached highlight of Figure 4 in Chen and the language in col. 2, lines 18-25. As to claim 1, note the indicated face wall (21), sole (22), backside wall and inclined frontward portion. As to claim 2, the drawing would appear to show a 60 degree angle between the inclined portion and the horizontal plane. As to claim 3, note that Chen indicates that the striking face is between 2 mm and 3.5 mm. Using this dimension as a guide, it is clear that the vertical extent of the inclined portion is at least 3 mm and certainly less than 30 mm. As to claim 5, the thickness appears to be decreasing from its lower edge to its upper edge. As to claim 7, the sole is clearly seen as having a rearwardly decreasing thickness. As

Art Unit: 3711

to claim 8, the ratio between the maximum and minimum thickness of the sole is "at most" 3.5. As to claim 12, here again, using the thickness of the face as a guide for interpreting the dimensions for the remainder of what is shown in the drawings, it would appear that the upper end of the backside wall is positioned at least 10 mm and certainly less than 30 mm vertically with respect to the horizontal plane. As to claim 14, the ratio of front end-to-rear end thickness for the sole is at least between 0.2 and 3.5, as evidenced by the drawings.

Claims 1, 2, 4 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen ('120). Reference is made to the attached highlight of Figure 3. As to claim 1, note the face portion (13), sole (16) and backside wall having an inclined frontward portion. As to claim 2, the drawing would appear to show a 60-degree angle between the inclined portion and the horizontal plane. As to claim 4, the inclined portion appears to have a substantially constant thickness. As to claim 11, the sole would appear to have a "substantially" constant thickness.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, lines 9 and 10, "so that the distance from said back face gradually decreases from its lower edge to upper edge" is not understood. Is the "distance" that is being measured the distance between the back surface and the backside wall, between

Art Unit: 3711

the back surface and the free upper end, or between the back surface and the inclined frontward portion? Is the applicant referring to the lower and the upper edge of the backside wall or of the inclined frontward portion? Note, the face portion also has a lower edge associated with it and recited n the claims. Clarification is requested.

As to claim 2, this claim depends from claim 1 and thereby shares the indefiniteness of claim 1.

As to claim 3, where is the 3 mm to 30 mm being measured from? Is this distance measured from the horizontal? Or, is this distance being measured from a lower boundary to an upper boundary of the inclined portion?

As to claim 4, this claim depends from claim 1 and thereby shares the indefiniteness of claim 1.

As to claim 5, the location of the lower edge and upper edge is not understood.

As to claim 6, is the minimum thickness being measured at the lower edge and is the maximum thickness being measured at the upper edge? Further, where are the upper and lower edges located with respect to, for example, the horizontal, the free end, the backside wall or the sole? Note, the face has also been described as having a lower edge.

As to claim 7, does the sole portion have a thickness decreasing backwards from the lower edge of the face portion?

As to claim 8, where are the minimum and maximum thickness values being measured from? Is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

Art Unit: 3711

As to claim 9, does the sole portion have a thickness increasing backwards from the lower edge of the face portion?

As to claim 10, where are the minimum and maximum thickness values being measured from? Is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

As to claim 11, is this a cross-sectional thickness? Is this dimension being measured in a plane perpendicular to the horizontal?

As to claim 12, where is the 3 mm to 30 mm being measured from? Is this distance measured from the horizontal?

As to claim 13, it is not clear exactly from what reference point the maximum and minimum distances are being measured.

As to claim 14, where are the front end and rear end located?

Claims 6, 9, 10 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note wall (124) in Sung. See Figure 5 in Young. Note cavity (22) in Turner. Back wall member (14) in Kobayashi is of interest. Note rear wall (12) in Teramoto. Nagai shows a rear wall of interest. See member (20) in Chen "045).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sebastiano Passaniti Primary Examiner Art Unit 3711

S.Passaniti/sp March 4, 2005